

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Trent J. Brundage

Art Unit: 2135
Conf. No.: 3545

Application No.: 10/686,495

Filed: October 14, 2003

VIA ELECTRONIC FILING

For: IDENTIFICATION DOCUMENT AND
RELATED METHODS

Examiner: Randal D. Moran

Date: February 13, 2007

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF
COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellants request review of the final rejection in the above-identified application. No amendment is being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheets. (No more than 5 pages are provided.)

Date: February 13, 2007

Respectfully submitted,

DIGIMARC CORPORATION

CUSTOMER NUMBER 23735

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By: Steven W. Stewart, Reg. No. 45,133/
Steven W. Stewart
Registration No. 45,133

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REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Sir:

Introduction

On appeal the final rejections of claims 73-106 will be reversed.

(The following reasons generally focus on claims 104-106 for brevity's sake; but the other rejections are believed deficient for at least analogous reasons.)

The Wang Patent does not teach or suggest electronic circuitry as claimed

A first reason supporting reversal is that U.S. Patent No. 5,337,361 (hereafter referred to as "the Wang patent") does not teach or suggest electronic circuitry carried on or in the substrate, where the electronic circuitry includes data stored therein (claim 104).

Electronic circuitry implies, e.g., physical circuits, structure or components that conduct or otherwise operate with electrical current and/or voltage. One example is electronic components included in smart cards; another example is an RFID; yet another example is electronic memory circuits or chips. (Of course, many other components and circuits will fall within the scope of this feature.)

Curiously, though, the Office Action cites the Wang patent at Col. 3, lines 58-61. Please see the final Office Action on page 5, lines 5-6 paragraph 12. This passage discusses a printed, two-dimensional barcode pattern – a PDF417. An example of the barcode pattern is shown in the Wang patent at Fig. 1A, item 18 (reproduced below).

But a printed PDF417 barcode is not electronic circuitry.

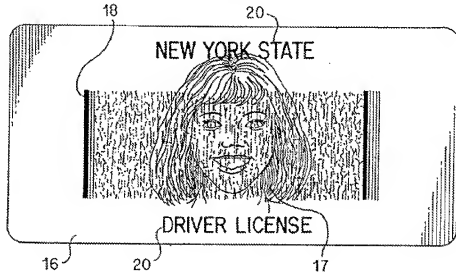


FIG. 1A

Indeed, even the popular on-line Wikipedia recognizes that:

A barcode (also bar code) is a machine-readable representation of information in a visual format on a surface.

....

Barcodes can be read by optical scanners called barcode readers or scanned from an image by special software.

See http://en.wikipedia.org/wiki/Bar_code (*underlining added*).

One of ordinary skill in the art would not confuse a PDF-417 barcode with electronic circuitry. The final rejection will be reversed for this reason alone.

The Wang Patent does not teach or suggest using information carried on or in a document to help access electronic circuitry or data stored therein

A second reason supporting reversal is that claim 104 recites – in combination with other features – information carried on or in the substrate is obtainable from optical scan data, where at least a portion of the information once obtained allows access to the electronic circuitry or data stored therein.

One example of “information carried on or in the substrate” is information obtained through optical character recognition (OCR) – like in claim 106. The OCR information – once obtained – allow access to the electronic circuitry or the data stored in the electronic circuitry. For example, the OCR information might include a key or other information to unlock, decrypt or otherwise allow access to the electronic circuitry or the data stored in the electronic circuitry.

Another example of “information carried on or in the substrate” is information carried with digital watermarking – like in claim 105. The digital watermarking information – once obtained – allows access to the electronic circuitry or the data stored in the electronic circuitry. For example, the digital watermarking information might include a key or other information to unlock, decrypt or otherwise allow access to the electronic circuitry or the data stored in the electronic circuitry.

(Of course, other examples will fall within the scope of claim 104. Thus, these examples are not meant to limit claim scope.)

The final Office Action cites the Wang patent at Col. 4, lines 3-12 and Col. 8, lines 38-41 to meet this feature. Please see the final Office Action on pages 5-6, lines 10-14 of paragraph 12; and please also *cf.* the final Office Action on page 11, lines 5-21.

The Col. 8, line 38-41, discussion is focused on decoding a two-dimensional barcode 18 carried by document 16 (please see Fig. 1A on page 2, above). There is no mention here of using other information (e.g., OCR information or digital watermark information) carried on or in the document to help access the two-dimensional barcode 18 or to help otherwise obtain data from the two-dimensional barcode 18.

The Col. 4, lines 3-12 discussion is not helpful either. That passage discusses information carried in barcode pattern 18 may relate to a holder of document 16. If document 16 is a driver's license, the barcode 18 may include information indicating that

the owner is not authorized to drive without corrective lenses. Or if document 16 is a passport, barcode 18 may include information indicating that the holder of the passport has visited certain countries. But, here again, there is no mention of using other information (e.g., OCR information or digital watermark information) carried on the document to help access the two-dimensional barcode 18 or to otherwise help obtain data from the two-dimensional barcode 18.

The final rejection will be reversed for this reason as well.

Steganographic Encoding

Dependent claims 81, 90 and 100 variously recite that symbols (claim 81) or information (claims 90 and 100) are steganographically encoded in a photographic-representation of an authorized bearer of an identification document.

In the context of these claims the phrase “steganographically encoded in a photographic-representation” implies data changing, altering or encoding. The encoding is preferably subtle, so as to be steganographic. For example, pixel values (or color or luminance values) may be subtly changed to encode data, or transform domain coefficients (e.g., DCT coefficients) may be altered, etc.

The cited passages in the Wang patent (Col. 3, lines 67- Col. 4, line 3) discuss printing an invisible ink over or on top of (see also Col. 3, lines 58-59) a photographic-representation. There is no teaching or suggestion at this passage, however, that symbols or information is steganographically encoded in a photographic-representation through data changing, altering or encoding.

These rejections will be reversed as well.

And claim 73 recites – in combination with other features – that a first graphic comprises steganographically encoding including a plural-bit first message that is machine-readable.

In the context of claim 73 the phrase “the first graphic comprising steganographic encoding” implies that the graphic is changed, altered or encoded to carry data. The encoding is preferably subtle, so as to be steganographic. For example, pixel values (or color or luminance values) may be subtly changes to encode data, or transform domain coefficients may be altered, etc.

While the Wang patent may discuss printing an invisible ink over or on top of a photographic-representation (see Col. 3, lines 58-59), there is no teaching or suggestion, however, that data is steganographically encoded in the first graphic.

We respectfully request that the rejection of claim 73 be withdrawn.

Remaining Claims

We respectfully submit that the final rejections of the other claims will be also reversed.

For example, claim 73 recites – in combination with other features – a first graphic includes steganographically encoding having a message with a code, where the code once obtained unlocks electronic circuitry or the information stored therein.

And claim 86 recites – in combination with other features – information carried on or in the substrate that is recognizable from optical scan data, where at least a portion of the information once recognized unlocks electronic circuitry or the data stored therein.

Claim 101 recites – in combination with other features – information carried on or in the substrate that is obtainable from optical scan data, where at least a portion of the information once obtained is to be utilized to unlock the electronic circuitry or the data stored therein.

The final rejection of the remaining claims will be reversed for at least reasons analogous to some of those mentioned above.

Conclusion

We respectfully request prosecution be reopened and a Notice of Allowance issued. The undersigned can be reached at 503-469-4685 with any questions.

Date: February 13, 2007

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Respectfully submitted,

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